

Application № 10/769,173
Reply to Final Office Action of May 9, 2008

REMARKS / ARGUMENTS

The present application includes pending claims 1-41, all of which have been rejected. Independent claims 1, 11, 21, and 32 have been amended. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0001386, issued to Akiyama (hereinafter, Akiyama), in view of U.S. Patent No. 6,073,237, issued to Ellison (hereinafter, Ellison). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 (“MPEP”) states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396

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(quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Akiyama and Ellison Does Not Render Claims 1-41 Unpatentable

The Applicant now turns to the rejection of claims 1-41 as being unpatentable over Akiyama in view of Ellison. The Applicant notes that the proposed combination of Akiyama and Ellison forms the basis for all of the pending rejections.

A. Independent Claim 1

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Akiyama and Ellison does not disclose or suggest at least the limitation of “encrypting the digitally signed secure key utilizing at least a previously generated unreadable digitally signed encrypted secure key,” as recited by the Applicant in independent claim 1. The Final Office Action states the following:

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Regarding Claim 1, Akiyama discloses a method for secure key authentication, the method comprising:

generating at a first location (Fig.29, This is a broadcast station where the contents, keys and digital signature for contact information etc, are generated and then sent to receivers) a digital signature (Fig. 5, "Digital signature") of a secure key to obtain a digitally signed secure key (Fig. 5, "work keys", also at paragraph 0107, "The digital signature is information used to check the " authenticity of the contract information, and is used to prevent tampering.", also at paragraph 0107, "The contract information is made up of, e.g., a receiver 10, channel contract information, the number n of work keys, n pairs of work keys and work key identifiers, and digital signature").

encrypting the digitally signed secure key utilizing at least a previously generated unreadable key (Fig. 7, "Enciphered contract information", also at Paragraph 0106, lines 5-8, "The individual control packet is comprised of an information identifier, master key identifier, and encrypted contract information, as shown in FIG. 7.", Note: *[Each digitally signed contract information is encrypted using a master key, also note that master keys are generated and sent to clients via secure card therefore master keys are generated prior to encrypting work keys and it is also unreadable because only broadcaster and receivers have the master key (see Paragraph 0154)]*)

See the Final Office Action at page 4. Referring to FIG. 5 of Akiyama, the Examiner has equated Applicant's "secure key" to Akiyama's "work key", which is part of Akiyama's contract information. Furthermore, Akiyama discloses that a separate master key is used to encrypt the work key, as illustrated in FIG. 3 and further explained in paragraph 0100 of Akiyama. Obviously, the work keys are different from the master keys, which are used for encrypting the work keys. In this regard, Akiyama does not disclose that the work keys (equated by the Examiner to Applicant's "secure key") are

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encrypted utilizing a previously generated unreadable digitally signed encrypted work key. In other words, Akiyama does not disclose that the work keys are encrypted using previously generated work keys, as recited in Applicant's claim 1. Ellison does not overcome the above deficiencies of Akiyama.

Therefore, the Applicant maintains that the combination of Akiyama and Ellison does not disclose or suggest at least the limitation of "encrypting the digitally signed secure key utilizing at least a previously generated unreadable digitally signed encrypted secure key," as recited by the Applicant in independent claim 1.

Accordingly, the proposed combination of Akiyama and Ellison does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 11, 21, and 32 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11, 21, and 32 are also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-10, 12-20, 22-31, and 33-41

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, 21, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Akiyama in view of Ellison has been overcome and requests that the rejection be

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withdrawn. Additionally, claims 2-10, 12-20, 22-31, and 33-41 depend from independent claims 1, 11, 21, and 32, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-10, 12-20, 22-31, and 33-41.

In general, the Final Office Action makes various statements regarding claims 1-41 and the cited reference that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

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CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-41 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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